UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,861	12/29/2004	Yasuo Ishiguro	82478-9900	9295

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ART UNIT	PAPER NUMBER
2167	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/519,861	ISHIGURO ET AL.
	Examiner	Art Unit
	SHERIEF BADAWI	2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5 and 16-18* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,5 and 16-18* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   The Amendment filed on June 30, 2008 has been received and entered. Application

10/519,861 Claims 1, 5 and 16-18 are now pending claims 2-4 and 6-15 have been cancelled.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

3.   **Claims 1, 5 and 16-18** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

        Claim 1 is rejected under 35 U.S.C. 101 because the claims recite "A patent information

searching apparatus", however claim 1 limitations do not include any physical structure to perform

the steps recited in claim 1. furthermore the claim fails to disclose a physical article or object for the

claimed system. These claims lack the necessary physical articles or objects to constitute a machine

or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to

be a process nor are they a combination of chemical compounds to be a composition of matter. As

such, they fail to fall within a statutory category. They are, at best, functional descriptive material per

se.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
> subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1, 5, 13, 14 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kraft et al. (US 6,137,488) Date of Patent October 24, 2000, in view of DialogWeb.com (March, 3

2000) and Further in view of East Text Search Training (published January 2000)

As per **<u>Claim 1</u>**, Kraft discloses a patent information searching apparatus for searching a

database based on a search criterion entered by a user, the patent information searching apparatus

comprising:

o   a database that stores a plurality of pieces of patent information data as search target,

(See Column.6, lines 20-28, wherein a patent data base information search fields is

disclosed; as taught by Kraft);

o   filed information as display flags that correspond one-to-one to data-entry fields to

be used by the user for entering the search criterion, **(See Fig.4, wherein the display flag +**

corresponds to search criterion to be entered by the user, See Fig.7, each display flag

corresponds to a search field; as taught by Kraft);

o   each display flag indicating whether or not to display a corresponding one of the

data-entry fields, **(See Fig. 5, wherein the + and – signs indicate either to display the data**

entry field; as taught by Kraft);

o   further hold character string data for displaying names of categories of the data-entry

fields, **(See Fig. 5, wherein the entry filed includes character string data to display category**

names; as taught by Kraft);

o   character string data for displaying names of the data-entry fields, **(See Fig. 5,
wherein the entry filed includes character string data to display category names; as taught
by Kraft);**

o   each data-entry field being categorized in any of the categories including a
classification category, a number category, a date category, a unique-name category and a text
category; **(See Column.2, lines 15-22 and Column.6, lines 20-30, user selects the desired
classification entry from a list of available classification entries, if the form being completed
is a patent database search query, some exemplary classification entries might be:
"description," "title," "inventor," "assignee," "licensee," "year," and a generic category
for data not belonging in the listed classification entries; as taught by Kraft);**

o   a category display unit displaying a list of the categories using the character string
data for displaying the names of the categories; **(See Column.6, lines 7-48, wherein a patent data
base information search fields is disclosed, wherein category fields can be added and
removed from the search using flags, wherein the fields correspond to text fields and
classification fields, year name; as taught by Kraft);**

o   a category receiving unit receiving, from the user, a selection of one or more
categories from the list of the categories; **(See Column.6, lines 20-27, wherein a list of
categories is displayed where a user can select form; as taught Kraft);**

o   a field list display unit displaying a list of data-entry fields in each of the selected
categories using the character string data for displaying the names of the data-entry fields, and not to
display a list of data-entry fields in the other categories that are not selected; **(See Fig.6, wherein
the categories and classes selected are displayed, and categories not selected are hidden
from the display; as taught by Kraft);**

o   a field receiving unit receiving, from the user, a selection of one or more data-entry

fields that are to be used for conducting the search from the data-entry fields displayed in the list;

(See Column.6, lines 28-36, wherein the data entry fields that are populated with common

preprogrammed values could be selected, and Fig.6, wherein fields that are added are used

for querying the database; as taught by Kraft);

o   an update unit updating the field information by setting display flags corresponding

to the selected data-entry fields and clearing display flags corresponding to the data- entry fields not

selected by the user; **(See Column.6, lines 38-55, see Fig. 4, wherein the entry and**

classification fields can be added and removed, wherein when the entry field is removed the

display removes the entry field and its flags, by that updates to the interface fields are

performed; as taught by Kraft);

o   a field display unit displaying, in accordance with the field information, the data-entry

fields for which the display flags have been set, and not displaying the data-entry fields for which

the display flags have been cleared; **(See Column.6, lines 38-55, see Fig. 4, wherein the entry**

and classification fields are be added and removed using, the interface changes based on

adding additional field templates; as taught by Kraft);

o   a data searching unit receiving the search criterion entered in the data- entry fields

displayed by the field display unit, and search for data matching the received search criterion; **(See**

Column.8, lines 20-25, allows the user to create sophisticated search terms by indenting the

appropriate field templates; as taught Kraft); and

o   a search result display unit displaying a result of the search conducted by the data

searching unit; **(See Column.14, lines 20-30, which receives the completed form, identifies any**

patents that satisfy the criterion set forth in the field templates, and returns a listing of those

patents to the user; as taught by Kraft).

However Kraft fails to disclose a field information holding unit holding, for each of a

plurality of user IDs and search purposes corresponding to procedures relating to patent.

On the other hand Dialogweb.com discloses a field information holding unit holding, for

each of a plurality of user IDs and search purposes corresponding to procedures relating to patent,

(See page.1, wherein an input filed to hold user Ids for the purpose of searches relating to

intellectual property; as taught by DialogWeb.com).

And receiving unit receiving a user ID of the user; **(See page.1, wherein an input filed to**

hold user Ids for the purpose of searches relating to intellectual property; as taught by

DialogWeb.com).

Therefore, it would have been obvious to a person of ordinary skill in the computer art at

the time of the invention was made to incorporate the DialogWeb.com teachings to Kraft system.

One skilled in the art at the time of the invention would have found it motivating a user based

search system to provide a customized and secure searching system. In addition, the references

(DialogWeb.com and Kraft) teach features that are directed to analogous art and they are directed to

the same field of endeavor, such as, Patent searching. This close relation between both of the

references highly suggests an expectation of success.

the combination of Kraft and East Text Search Training discloses Wherein data-entry fields

categorized in the classification category are Classification by four industrial property laws, IPC, FI,

and F Term, the data-entry fields categorized in the number category are Application Number,

Publication Number, International Application Number, International Publication Number,

Unexamined Patent Publication Number, Examined Patent Publication Number, Registration

Number, Priority Number, Related Application Number, and Number of Appeal, the data-entry

fields categorized in the date category are Date of Filing, Date of Publication of Application, Date of

Filing of International Application, Date of Publication of International Application, Date of

Publication of Unexamined Patent Application, Date of Domestic Re-Publication of PCT

International Application, Date of Publication of Official Gazette, Date of Publication of Examined

Patent Application, Date of Registration, Date of Publication for Registered Patent, and Date of

Filing of Application Claiming Priority, the data-entry fields categorized in the unique-name category

are Applicant/Right-Holder, Inventor, Representative, Examiner, and Designated Country, and the

data-entry fields categorized in the text category are Title of the Invention, Detailed Description of

the Invention, Claim(s), Field of the Invention, Description of the Prior Art, Problem(s) to be

Solved by the Invention, Means for Solving the Problem(s), Embodiment of the Invention, Effect

of the Invention, Brief Description of the Drawings, Description of Characters, Abstract, Abstract

+ Claim(s), and Full Text; **(See Fi.4 of Kraft pages 15—1 through 15-7, wherein the pervious**

fields have been disclosed as search description fields used in the east search system; as

taught by Kraft and East Text Search System)

Therefore, it would have been obvious to a person of ordinary skill in the computer art at

the time of the invention was made to incorporate the East Text Search Training teachings to the

combined Kraft and DialogWeb.com system. One skilled in the art at the time of the invention

would have been motivated to include a variety of search fields to provide the user plurality of

search filed to facilitate an easier and direct search system for the user. In addition, the references

(Kraft, DialogWeb.com and East Text Search Training) teach features that are directed to analogous

art and they are directed to the same field of endeavor, such as, Patent searching systems. This close

relation between both of the references highly suggests an expectation of success.

As per **Claim 5**, the rejection of claim 1 is hereby incorporated by reference; the combination of Kraft, DialogWeb.com and the East Text Search Training further discloses the category display unit displays the list of the categories on a screen where the data-entry fields are displayed by the field display unit, **(See Fig.4, wherein plurality of categories are displayed on the screen; as taught by Kraft)** the field list display unit displays the list of the data-entry fields on the screen where the data-entry fields are displayed by the field display unit, **(See Fig.5 and Fig.6, wherein plurality of entry fields such as 308 and 500 are displayed; as taught by Kraft)** and the field display unit updates the displayed data-entry fields immediately when the field receiving unit receives the selection of the data-entry fields; **(See Column.7, lines 1-16, wherein additional entry field is displayed after a selection to do so; as taught by Kraft).**

As per **Claim 16**, the rejection of claim 1 is hereby incorporated by reference; the combination of Kraft, DialogWeb.com and the East Text Search Training discloses the field receiving unit receives from the user, a selection two or more data-entry fields that are to be used for conducting the search from the data-entry fields displayed in the list; **(See Column.6, lines 20-27, wherein a list of categories is displayed where a user can select from, See Column.6, lines 28-36, wherein the data entry field could be a preprogrammed list of expected input data, wherein the in the list two or more selection can be made, wherein the entry filed could be a checkable list, See Column.6, lines 10-25; as taught Kraft)** the update unit updates the field information by setting display flags corresponding to the two or more selected data-entry fields and clearing display flags corresponding to data-entry fields not selected by the user, **(See Column.6,**

lines 38-55, see Fig. 4, wherein the entry and classification fields can be added and removed, wherein when the entry field is removed the display removes the entry field and its flags; as taught by Kraft) and the field display unit, in accordance with the field information, simultaneously displays the two or more data-entry fields for which the display flags have been set, and not display the data-entry fields for which the display flags have been cleared; **(See Column.6, lines 38-55, see Fig. 4, wherein the entry and classification fields can be added wherein the display adds the field with the flag indication of addition and removed, wherein when the entry field is removed the display removes the entry field and its flags; as taught by Kraft).**

6.   <u>Claim 17,</u> is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (US 6,137,488) Date of Patent October 24, 2000, in view of DialogWeb.com (March, 3 2000), and Further in view of East Text Search Training (published January 2000) as applied to claim 1 above and further in view of Lahey (US 6,384,923) Date of Patent May 7, 2002.

As per <u>**Claim 17**</u>, the rejection of claim 1 is hereby incorporated by reference, ; the combination of Kraft, DialogWeb.com and the East Text Search Training discloses a user ID input unit to accept a user ID; (See dialogWeb.com, wherein the user inputs a user ID to enter the site)

However ; the combination of Kraft, DialogWeb.com and the East Text Search Training fails to disclose wherein the display flags are associated with the user such that the display flags are preserved when the user is accepted at a subsequent period of time.

On the other hand Lahey discloses wherein the display flags are associated with the user such that the display flags are preserved when the user is accepted at a subsequent period of time; **(See column.15, lines 45-65, wherein the customized interface with customized search fields is preserved for each user as set by the user; as taught by Lahey).**

Therefore, it would have been obvious to a person of ordinary skill in the computer art at

the time of the invention was made to incorporate the Lahey teachings to the combined Kraft,

DialogWeb.com and East Text Search Training system. One skilled in the art at the time of the

invention would have found it motivating to use personalized information retrieval system of Lahey

into the full-text search and query system of Kraft for the purpose retrieving data from a server

based upon a defined and stored user profile of desired information to expedite the search process

for each user based on preferences;. In addition, the references (Kraft, DialogWeb.com, East Text

Search Training and Lahey) teach features that are directed to analogous art and they are directed to

the same field of endeavor, such as, querying databases. This close relation between both of the

references highly suggests an expectation of success.

7.   **Claim 18,** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (US

6,137,488) Date of Patent October 24, 2000, in view of DialogWeb.com (March, 3 2000), in view of

East Text Search Training (published January 2000) and further in view of Lahey (US 6,384,923)

Date of Patent May 7, 2002, as applied to claim 17 above and further in view of Kasahara et al. (US

5,123,088) Date of Patent June 16, 1992.

As per **Claim 18**, the rejection of claim 17 is hereby incorporated by reference, the

combination of Kraft, DialogWeb.com, East Text Search Training and Lahey further discloses

wherein the display flags have been set, and the display flags have been cleared; **(See Column.6,**

lines 7-48, wherein entry field display flags are used to add or remove fields; as taught by

Kraft). However the combination of Kraft, DialogWeb.com, East Text Search Training and Lahey

is silent with respect to having the display flags with associated values 1 and 0.

On the other hand Kasahara teaches to having display flags with associated values 1 and 0; **(See Column.7, lines 56-60; wherein display flags are hold the values 1 and 0; as taught by Kasahara).**

Therefore, it would have been obvious to a person of ordinary skill in the computer art at the time of the invention was made to incorporate the Kasahara teachings to the combined Kraft, DialogWeb.com, East Text Search Training and Lahey system. One skilled in the art at the time of the invention would have found it motivating use different display flag values to easily distinguish between visible and invisible entry fields. In addition, the references (Kraft, DialogWeb.com, East Text Search Training, Lahey Kasahara) teach features that are directed to analogous art and they are directed to the same field of endeavor, such as, display or view properties. This close relation between both of the references highly suggests an expectation of success.

Conclusion

8.   The examiner requests, in response to this Office action, support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

9.   When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Point of Contact

10.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to SHERIEF BADAWI whose telephone number is (571)272-9782. The

examiner can normally be reached on Monday through Friday 7:30-5:00, Alt Friday off.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization

where this application or proceeding is assigned is 571-273-8300.

        Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John R. Cottingham/   Sherief Badawi
Supervisory Patent Examiner, Art Unit 2167   Art Unit 2167
                                                             11-7-2008   VFB

/lsw/
7 November 2008